

REMARKS

In the application claims 6-9, 11, and 15-19 remain pending. Claims 1-5, 10, 12-14, 20-32 have been canceled without prejudice and will be filed in a continuation application.

The pending claims presently stand rejected under 35 U.S.C. § 103 as being rendered obvious primarily by Lord (U.S. Patent No. 6,593,976). In rejecting the claims, the Office Action has relied on legal precedents that the mere integration of components is considered to be an obvious modification to one of ordinary skill in the art. Accordingly, the Office Action concluded that it would have been obvious to modify Lord by integrating the remote (25) and controller (20) to reduce the number of separate elements in the system.

The reconsideration of the rejection of the claims is, however, respectfully requested.

It is respectfully submitted that a rejection under 35 U.S.C. § 103 requires that a combination of references disclose, either expressly or inherently, each and every element set forth in the claims, considering the claims “as a whole.” The requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the manner claimed.

As concerns the demonstration of obviousness required to establish a *prima facie* case of obviousness, it appears that the rejection of the subject claims is attempting to provide this demonstration by impermissibly drawing from the decisions in In re Larson and In re Wolfe, which turn on specific facts, a general obviousness rule, namely, that forming several pieces integrally as a one-piece structure is not considered to be patentable subject matter. No such *per se* rule exists. See In re Hubbell, 164 F.2d 700 (CCPA 1941) or Schenck v. Norton Corp., 713 F.2d 782 (Fed. Cir. 1983) (The argument that the invention was just making integral that which was separate was found unpersuasive because the prior art perceived a need for mechanisms to dampen resonance whereas the inventor eliminated that need thus showing insight contrary to the understandings and expectations of the art). Rather, when using “legal precedent” as a basis for establishing obviousness it must be demonstrated that the facts in a prior legal decision being relied upon are sufficiently similar to those in the application under consideration. Since it has not been demonstrated, or even alleged, that the facts in In re Larson and In re Wolfe are sufficiently similar to those in the subject application, which they are not, the rejection of the claims must be withdrawn for failing to present a *prima facie* case of obviousness.

Considering the facts of the subject application, it is respectfully submitted that the facts underlying the “legal precedent” established in Schenck v. Norton Corp. are more similar to the facts in the subject application than are the facts underlying the “legal precedent” in either In re Larson and In re Wolfe. As was the case in Schenck v. Norton Corp., the claimed invention shows insight contrary to the understandings and expectations of the art. For example, contrary to the understandings and expectations of either Lord or Johnson (cited EP-0366001), which disclose appliances that need to be pre-equipped with specialized hardware and software to recognize a specific command transmitted by a remote control to perform a specific “remember”

or “return to channel” operation, the claimed invention eliminates this need and allows any media playing device, even those without the pre-equipped, specialized hardware and software, to have a return to channel feature. Accordingly, contrary to the position taken in the Office Action, it is respectfully submitted that the “legal precedent” of Schenck v. Norton Corp. demonstrates the patentability of the invention claimed and, for this reason, the rejection must be withdrawn.

Still further, even assuming that the “legal precedent” established by In re Larson and In re Wolfe does demonstrate that it would have been obvious to modify Lord to “integrate the remote 25 and the controller 20 [to] reduce the number of separate elements in the system and increase the number of components/software in remote 24,” which it does not, it is respectfully submitted that the espoused integration of the components/software of the controller 20 into the remote control 24 to thereby arrive **at the invention claimed** would require the impermissible changing of the principle of operation of the Lord system. In this regard, the system of Lord operates on the principle of using the reappearance of content on a previously viewed channel to cause a return to a displaying of the content playing on that channel. For this purpose, the controller 20 functions to store in memory a “fingerprint” of an A/V signal currently appearing on a channel (Col. 4, lines 6-24) and, when a “fingerprint compare unit” detects that the “fingerprint” of the A/V signal on that channel is sufficiently similar to the “fingerprint” stored in memory, the system functions to return to a displaying of the content that is playing on that channel. (Col. 6, lines 10-18). While Lord does describe that the “fingerprint compare unit” can adjust a confidence threshold (S87 of Figs. 3 and 4) that is used when measuring the similarity between the stored “fingerprint” and the current “fingerprint” of an A/V signal based upon a

number of different criteria, one of which may be time, the system of Lord still requires and remains centered around the principle of detecting a “fingerprint match” (S88 of Figs. 3 and 4):

Importantly, when the channel setting of the main tuner 40 is changed in step S86, the channel setting of the aux tuner 40 is not changed, and the aux tuner remains set to the original channel that was being viewed when the remember button was pressed.

Because of this, the fingerprint compare unit 42 can monitor the original channel and wait for a fingerprint that matches the fingerprint stored in the fingerprint memory 41.

(Col. 8, lines 5-13, emphasis added).

Thus, were one to modify Lord for the purpose of arriving at the system that is claimed, i.e., one in which a remote control has elements that allow it to perform a return to channel operation *without regard to the current state of media being played by a media device*, the core principle of the operation of the Lord system would have to be omitted from the system so modified, i.e., to arrive at the system that is claimed the controller 20 would have to be additionally modified to no longer allow for the monitoring of the current state of the media playing on the aux channel of the media device or the performing of the “important” process step (S88 of Figs. 3 and 4) of determining if the current state of the media playing on the media device, as represented by its “fingerprint,” matches a previously captured “fingerprint” of the media playing on the media device. Since it is impermissible to espouse a modification that would change the principle of operation of the reference being modified (e.g., one that would eliminate step S88 of Figs. 3 and 4 of Lord), it is submitted that a *prima facie* case of obviousness has not been presented and that the rejection of the claims must be withdrawn. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

In sum, the rejection of the claims fails to establish a *prima facie* case of obviousness. No evidence has been placed into the record which can be said to demonstrate that an artisan of skill in the art would have been led to modify Lord to incorporate into a remote control the

claimed elements that allow a remote control to provide users with the ability to provide any media playing device with a return to channel feature. Absent this evidence, it can only be concluded that the suggestion to modify Lord in the manner proposed in the Office Action resulted from hindsight knowledge derived from the subject application. Since the use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is impermissible, the rejection of the claims must be withdrawn.

CONCLUSION

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

Respectfully Submitted;



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